REMARKS

These amendments and remarks are in response to the Official Action mailed on December 27, 2003. Claims 1-25 were pending. Claims 1-15 were rejected. Claims 16-25 were withdrawn from further consideration by the Examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claims 1, 6, 11, 13 and 14 are amended. Claim 10 is cancelled. Claims 26 and 27 are added. Reconsideration and withdrawal of the rejections are respectfully requested in light of the amendments and the following remarks.

Claims 1-5 and 7-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,948,323, issued to *McLaughlin et al.* ("*McLaughlin*") in view of United States Patent No. 5,072,028, issued to *Fishler et al.* ("*Fishler*"). Applicants respectfully traverse. Claim 10 has been cancelled, and therefore, is not addressed. Applicants address the rejection as to claims 1-5, 7-9 and 11-12. For reference, base claim 1 is directed to a suspension of Pentabromobenzyl acrylate ("PBBMA") and base claim 12 is directed to a process for making the suspension of PBBMA.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. Moreover, the combination must teach or suggest all of the claimed elements. *See Id.* "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must <u>both</u> be found in the prior art..." *Id.* (emphasis added); *see also In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "The mere fact that references <u>can</u> be combined or modified does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (emphasis in original) (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Here, *McLaughlin* does not suggest that PBBMA should be among the fire retardants from which the colloidal particles can be made. In fact, *McLaughlin* actually excludes PBBMA. Instead, *McLaughlin* teaches an aqueous dispersion of flame retardant and/or smoke suppressant compounds, a list of which includes "solid halogenated flame retardants with a melting point greater than 250°C. (such as brominated polymers, decabromodiphenyloxide ethylene bistetrabromophthalamide, decabromodiphenylethane, and dodecachlorododecahydrodimethanodibenzocyclooctene)." (Col. 2, lns. 8-29). Nowhere in *McLaughlin* is PBBMA specifically listed as a possible flame retardant and/or smoke suppressant compound with a melting point greater than 250°C. This is probably not an accident. The omission of PBBMA from the teaching of *McLaughlin* is likely because PBBMA has a melting point of less than 130°C. Therefore, *McLaughlin* affirmatively, if functionally, excludes PBBMA from the list of fire retardants because *McLaughlin* requires fire retardants with melting points about 100% higher than the melting point of PBBMA.

The Examiner merely cites *Fishler* for its disclosure of monomers, particularly PBBMA, which possess "outstanding flame-retardant properties." (Col. 2, ln. 7). *Fishler*, however, does not disclose suspensions of PBBMA or the use of suspensions for the production of PBBMA. *Fishler* also does not suggest that PBBMA could be substituted for the flame retardant and/or smoke suppressant compounds of *McLaughlin* in any context, let alone in the context of a suspension.

Simply put, there is no teaching or suggestion in these references themselves to support their combination or modification. It would not have been obvious to one of ordinary skill in the art to combine or modify the teachings of *McLaughlin*, which discloses the flame retardant suspensions with melting points above 250°C, with the teachings of *Fishler*, which discloses solid flame-retardants, such as PBBMA, having a melting point well below that temperature. Additionally, neither reference suggests the desirability of such a combination. Therefore, Applicants respectfully submit that the § 103 rejection should be withdrawn.

Because claims 2-9, 11, 13-15 and 26-27 directly or indirectly depend from base claims 1 and 12, they include each of its novel features. Therefore, Applicants respectfully submit that claims 2-9, 11, 13-15 and 26-27 are allowable over *McLaughlin* in view of each of the secondary references.

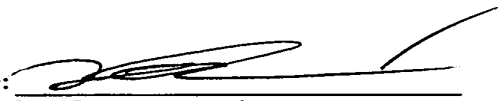
The Examiner has rejected claims 1, 2, 10, 11, 13 and 14 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Claim 10 has been cancelled, and therefore, the rejection with respect to this claim is now moot. Claims 1, 2, 11, 13 and 14 have been amended to address the Examiner's concerns. Further, new claims 26 and 27 have been added and contain subject matter that is supported by the specification. Therefore, Applicants respectfully submit that the 35 U.S.C. § 112, second paragraph, rejection has been overcome with respect to these claims.

Since the amendments place the claims in condition for allowance and each of the rejections has been overcome, Applicants respectfully submit that the amendments be entered in the application. In view of the above, each of the presently pending claims in this application is believed to be

in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 22, 2003 Respectfully submitted,



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